

Appl. No. 09/939,250
Amdt. Dated February 3, 2004
Reply to Office Action of November 13, 2003

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-6 and 8-27 remain in the application. Claims 1, 4-6, 8-10, 15-18, 20-22, and 24-27 have been amended. Claim 7 has been canceled.

In item 2 on page 2 of the above-identified Office Action, claims 1, 2, and 8 have been rejected as being anticipated by any of Miwa et al. (U.S. Patent 5,228,139) (hereinafter "Miwa"), Cummins et al. (U.S. Patent 5,359,547) (hereinafter "Cummins"), or Ogino et al. (U.S. Patent 5,416,919) (hereinafter "Ogino") under 35 U.S.C. § 102(b).

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found in the original claims and on page 13, lines 3-13 of the specification of the instant application.

More particularly, claim 1 has been amended to recite, among other things, the resetting feature previously recited in dependent claim 7 and the feature relating to the readiness of

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the test program to receive data/instructions as further described in the instant specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a method for testing a program-controlled unit having a test program associated therewith, which has the steps of:

providing an external test device for executing, in the program-controlled unit, the test program which at least one of initiates, performs and supports the testing of the program-controlled unit;

starting the test program by resetting the program-controlled unit; and

checking the readiness of the test program to accept data.

(emphasis added)

Miwa discloses a semiconductor device with a test mode for testing a CPU using an external signal. In a testing of the device a test signal TEST12 is directly supplied to the internal bus 14 from the outside to a functional module. There is no suggestion or disclosure in Miwa of the program-

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controlled unit being reset after the creation of the preconditions necessary for execution of the test program or checking the readiness of the test program to accept data/instructions as recited in the instant claims.

Cummins discloses testing processor-based computer modules using test code from an external test system to be substituted for initialization code. Following initialization, a two way communication link between the processor and the test system is created to allow interactive testing and status reporting. There is no suggestion or disclosure in Cummins of the program-controlled unit being reset after the creation of the preconditions necessary for execution of the test program or checking the readiness of the test program to accept data/instructions, as recited in the instant claims.

Ogino discloses a semiconductor integrated circuit having functional blocks which are capable of being individually tested externally. A selection circuit includes a test mode control circuit and a signal control circuit. The test mode control circuit generates and supplies control signals in response to test operating signals. There is no suggestion or disclosure in Ogino of the program-controlled unit being reset after the creation of the preconditions necessary for execution of the test program or checking the readiness of the

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test program to accept data/instructions, as recited in the instant claims.

The references do not show "starting the test program by resetting the program-controlled unit; and checking the readiness of the test program to accept data" as recited in claim 1 of the instant application.

In item 3 on page 2 of the above-identified Office Action, claims 4, 15, 17-20, 24, 26, and 27 have been rejected as being anticipated by Cummins under 35 U.S.C. § 102(b).

The foregoing discussion of Cummins is applicable in this rejection.

The claims depend directly or indirectly from claim 1 and are considered patentable at least for the same reasons as stated above for claim 1.

In item 5 on page 3 of the above-identified Office Action, claims 3 and 5-7 have been rejected as being unpatentable over any of Miwa, Cummins, or Ogino each further in view of Tanaka et al. (Pub. US 2003/0182084 A1) (hereinafter "Tanaka") under 35 U.S.C. § 103(b).

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The foregoing discussions of Miwa, Cummins, and Ogino are applicable in this rejection.

Further, applicants respectfully note that the Tanaka Pub. No. U.S. 2003/0182084 has an effective date as a reference of Sept. 25, 2003 or July 4, 2001 (if the PCT/JP01/05787 on which it is based was published in English and if not, then the former date applies). See 35 U.S.C. § 102(e). As set forth in the Declaration of record, the instant application claims international priority of the German Application No. 100 41 697.7, filed April 24, 2000, under 35 U.S.C. § 119. Pursuant to 35 U.S.C. § 119, applicants are entitled to the priority date of the aforesaid German Application. See MPEP §§ 201.13 and 1895. Thus, the instant application predates Tanaka at least by more than fourteen months. Because Tanaka was filed after the priority date of the instant application, applicants respectfully believe that Tanaka is unavailable as prior art against the present claimed invention.

Applicants acknowledge that perfection of priority can only be obtained by filing a certified English translation of the German priority application. See 35 U.S.C. § 119. Applicants previously have filed a Claim for Priority and a certified copy of German Application No. 100 41 697.7 (both filed October 31, 2001) and now enclose a certified English

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translation of same. Accordingly, applicants respectfully believe that priority has been perfected and Tanaka is unavailable as prior art against the present claimed invention. Therefore, applicants respectfully submit that the Section 103 rejection on page 3 of the Office Action is now moot and request that the Examiner withdraw the rejection.

Because the rejection of the claims is deemed moot, discussion of the Tanaka reference is not deemed necessary at this time.

The claims are considered patentable because the primary references are deficient as discussed above and the secondary Tanaka reference is not available to overcome the deficiencies.

In item 6 on page 5 of the above-identified Office Action, claims 9-12, 14, 16, and 25 have been rejected as being unpatentable over any of Miwa, Cummins, or Ogino under 35 U.S.C. § 103(b).

The foregoing discussions of Miwa, Cummins, and Ogino are applicable in this rejection.

The Examiner has not cited any prior art or stated any valid reason that overcomes the deficiencies of these references.

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In the rejection of claims 9-12, 14, 16, and 25 the Examiner has taken notice on at least three separate occasions that certain features are known in general, are known, or are well-known, without citing any basis or support for such statements. It is respectfully submitted that the statements are based on wishful thinking and conjecture on the part of the Examiner. They are not based on any disclosures in the prior art. The Examiner has analyzed the instant claims and determined that the prior art does not show certain features recited in the claims and then, to make up for the deficiencies of the prior art, the Examiner concludes without support that the features that are not shown in the prior art are well known. Such an analysis is improper.

Therefore, the claims are considered patentable.

In item 7 on page 6 of the above-identified Office Action, claim 13 has been rejected as being unpatentable over any of Miwa, Cummins, or Ogino each further in view of Matsumoto (U.S. Patent 5, 657,330) under 35 U.S.C. § 103(b).

The foregoing discussions of Miwa, Cummins, and Ogino are applicable in this rejection.

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Matsumoto discloses a microprocessor chip with a built in self-testing function. Devices with self-testing capability and their disadvantages have been disclosed on page 3, lines 1-24 of the instant specification. Matsumoto discloses no more than what applicants already have acknowledged as prior art and does not overcome the deficiencies of the primary references. Moreover, the Examiner has not shown any motivation, suggestion, or reason for combining Matsumoto with Miwa, Cummins, or Ogino, other than an unsupported general conclusionary statement, namely, "so as to receive the expected benefits derived therefrom...." The foregoing statement is not a valid or proper basis or sufficient reason for combining the references as proposed by the Examiner. It is simply the Examiner's futile attempt to arrive at the claimed method by relying on hindsight reconstruction of the prior art in view of applicants' disclosure.

Therefore, the claims are considered patentable over the prior art as applied by the Examiner.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The

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dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

Finally, applicants appreciatively acknowledge the Examiner's statement that claims 21-23 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In light of the above, applicants respectfully believe that rewriting of claims 21-23 is unnecessary at this time.

In view of the foregoing, reconsideration and allowance of claims 1-6 and 7-27 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required petition for extension is herewith made.

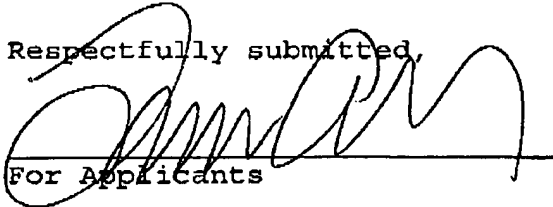
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Please charge any other fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicants

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FDP/tk

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